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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,337	02/11/2004	Andre Jestin	042049-0110	8520
22428	7590	01/21/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			SALIMI, ALI REZA	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,337

Applicant(s)

JESTIN ET AL.

Examiner

A R Salimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/524,245.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/11/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-12 are pending.

Raw Sequence Listing have been entered.

Submitted Information Disclosure Statement (I.D.S) is noted.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Please insert the US patent number.

Claim Rejections - 35 USC § 112

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for induction of antibody response and method of inducing immune response, does not reasonably provide enablement for composition/method for modulating cellular replication of PCV-B or alternatively a composition for inhibiting viral replication/method of inhibiting viral replication which in effect reads on protective response (vaccine). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The scope of the claims regarding inhibition of viral replication reads on a vaccine development. In addition, the claims are also read on "modulating cellular replication." The

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common meaning of “modulating” refers to “alteration”, increase or decrease of replication.

However, the disclosure does not provide any example, or any teaching as to how this may work, or what one of ordinary skill in the art should be alerted to. There is nothing in the specification that points to alteration of genes or inhibition of viral replication. Still further, Applicants are reminded that the field of vaccine development is considered to be highly unpredictable.

According to the specification and the state of the art the currently claimed virus attacks the immune system and disables the immune response. The current specification does not teach nor enables a vaccine or composition that inhibits viral. The disclosure makes scant remarks regarding method of selection of compounds that would bind the genes and inhibit expression of genes, but this is not adequate teaching, there are no teachings as to what genes are targeted, and/or should be targeted. There is no teaching as to class of compounds that can be identified to perform the methods. Absent teaching by the specification it would require undue experimentation for one ordinary skill in the art to enable the scope of the claims. The specification provides no teaching as to the inhibition of viral replication. Therefore, considering large quantity of experimentation needed, the unpredictability of the field, the state of the art, and breadth of the claims, it is concluded that undue experimentation would be required to enable the invention. Therefore, considering large quantity of experimentation needed, the unpredictability of the field, the state of the art, and breadth of the claims, it is concluded that undue experimentation would be required to enable the intended claim. Many of these factors have been summarized *In re Wands*, 858 F.2d 731, USPQ2d 1400 (Fed. Cir. 1988).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a **written description** of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant disclosure, the applicants have not disclosed the composition that would modulate cellular replication or alternatively would inhibit replication of PCV-B. There is no information in the specification that applicants were in **possession** of the claimed composition, and if no compositions are taught then Applicants were not in possession of the methods either. In addition, there is not enough information about it in literature either to guide the one of ordinary skill in the art to predict the undisclosed compositions. See also *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997), which teaches that the disclosure of a process for obtaining cDNA from a particular organism and the description of the encoded protein fail to provide an adequate written description of the actual cDNA from that organism which would encode the protein from that organism, despite the disclosure of a cDNA encoding that protein from another organism. 35 USC 112 requires inter alia that a patent specification contain a written description of the invention and the manner and process of making and using it "in such full clear and concise terms as to enable one skilled in the art ... to make and use" the invention. Case law has made it

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clear that the requirements for a "written description" and an "enabling disclosure" are separate. For example, where a specification contains sufficient information to enable a skilled chemist to produce a particular compound because it gives detailed information on how to produce analogous compounds but it makes no reference to the compound in question, the "written description" requirement has not been met even though the description may be enabling.

See *University of California v. Eli Lilly*, 119 F.3d 1559, 43 USPQ 2d 1398 (Fed. Cir. 1997):

The name cDNA is not in itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA Accordingly, the specification does not provide a written description of the invention

and at pg 1406:

a generic statement such as "vertebrate insulin cDNA" or "mammalian insulin cDNA," without more, is not an adequate written description of the genus because it does not distinguish the genus from others, except by function. It does not specifically define any of the genes that fall within its definition. It does not define any structural features commonly possessed by members of the genus that distinguish them from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the genes does, not what it is.

See *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ 2d 1016 at page 1021:

A gene is a chemical compound, albeit a complex one, and ... conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials Conception does not occur unless one has a mental picture of the structure of the chemical or is able to define it by its method of preparation, its physical or chemical properties, or whatever characteristics sufficiently distinguish it. It is not sufficient to define it solely by its principal biological property, e.g., encoding human erythropoietin, because an alleged conception having no more specificity than that is simply a wish to know the identity of any material with that biological property.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al (US Patent No. 6,517,843 B1).

The claims are directed to composition and method of that would modulate cellular replication of PCV-B. In addition, the claims are also directed to a composition that would inhibit viral replication. Ellis et al taught a composition for reducing viral load and a method of reducing viral load which reads on the limitations of “modulating”, hence the teaching of the cited patent anticipates the claimed invention (see all the claims). In addition, they taught inactivated immuogens (see Column 2, lines 33-36). Still further, they taught recombinantly produced immunogen (see Column 5, lines 54-55). Moreover, the product disclosed by Ellis et al would be able to inhibit viral replication, absent to the contrary evidence. The claiming of a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. *In re Best*, 562 F.2d1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Still further, Applicants are reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products. Moreover, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Claims 1-2, 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Allan et al (US Patent No. 6,660,272 B2).

The teaching and claims of the above cited patent meets the broad recitation of the claims (see for example claims 1, 8 and 2). The cited patent broadly disclosed an isolated circovirus II and various circovirus type II isolates, which would inherently have the capability to modulate or inhibit viral replication of PCV-B. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 1-2, 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Allan et al (US Patent No. 6,391,314 B1).

The product taught and claimed in the above cited patent meets the broad recitation of the claims (see claims 1-4). In addition, the cited patent taught inactivated PCV-B (see Column 3, lines 16-18).

Claims 1-2, 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Allan et al (US Patent No. 6,217,883 B1).

The product taught and claimed in the above cited patent meets the broad recitation of the claims (see claims 1-2, 7).

Claims 1-2, 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Allan et al (US Patent No. 6,368,601 B1).

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The product taught and claimed in the above cited patent meets the broad recitation of the claims (see claims 1, 9, 32). In addition, the cited patent taught inactivated PCV-B (see Column 3, lines 16-18).

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. The Official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. R. Salimi

1/13/2005

ALI R. SALIMI
PRIMARY EXAMINER